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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79011373
Applicant	RIGHT-ON CO., LTD.
Applied for Mark	HONEYSUCKLE ROSE
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TRADEMARK

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re the Application of: Right-On Co., Ltd.

Trademark Attorney: Melissa Vallillo

Application No.: 79/011,373

Law Office: 113

Filed: April 21, 2005

Docket No.: 127939

Mark: HONEYSUCKLE ROSE

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

EX PARTE APPEAL REPLY BRIEF

Applicant, Right-On Co., Ltd. (hereinafter "Right-On"), through its attorneys, hereby replies to the Examining Attorney's Answer to Applicant's Appeal Brief. The issue before the Trademark Trial and Appeal Board is whether the Examining Attorney's refusal to register the stylized mark, HONEYSUCKLE ROSE, in connection with "*clothing, namely, jeans, t-shirts, polo shirts, sweatshirts, sweaters, gloves and socks; belts; footwear, namely, sports shoes, mountaineering boots and sandals; headgear for wear, namely, caps and hats,*" should be reversed. More specifically, the issue is whether there is a likelihood of confusion between Applicant's mark and the cited mark of U.S. Registration No. 2,653,702.

Argument

This reply responds to the Examining Attorney's Answer to Applicant's assertion that its block-stylized mark HONEYSUCKLE ROSE is *not* likely to be confused with the registered HONEYSUCKLE and floral design mark due to stark differences in appearance, meaning, and sound.

The standard commercial impression analysis compares the marks in meaning, sound, and appearance; these are the primary ways in which marks are encountered in the marketplace. *Universal Money Centers, Inc. v. Am. Tel. and Tel. Co.*, 22 F.3d 1527, 30 USPQ2d 1930, 1933 (10th Cir. 1994). All relevant facts pertaining to appearance, meaning, and sound must be considered before similarity as to one or more of these factors may be sufficient to support the finding that the marks are dissimilar or similar. *Recot v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). The Examining Attorney continues with improper piecemeal analysis of Applicant's mark and fails to answer Applicant's arguments as to all three factors, as discussed below.

HONEYSUCKLE ROSE DIFFERS FROM THE ONE-WORD MARK HONEYSUCKLE IN MEANING SOUND AND APPEARANCE

A. MEANING

While it may be "well settled" that marks may be confusingly similar in appearance where there are similar terms or phrases appearing in both marks, addition of terms or phrases that change the meaning of a mark transform subtle differences into obvious ones and obviate even possible confusion. In supporting her theory that Applicant's mark may be confused with the registered mark despite the addition of a word and the differences of the designs, the Examining

Attorney cites cases wherein opposing marks include negligible differences, none of which provide different connotations to the marks. Unlike the cases cited by the Examining Attorney, Applicant's mark, which includes the word HONEYSUCKLE ROSE in a block-stylized font, differs in meaning substantially from the registered mark, which includes the single word HONEYSUCKLE wrapped in a floral design

For example, in *Crocker National Bank v. Canadian Imperial Bank of Commerce*, the marks differed by a mere three letters added to an abbreviation of the root word communication: 'COMCASH' versus 'COMMUNICASH.' The additional letters did not change meaning and attributed negligible difference in appearance and sound. 228 USPQ 689 (TTAB 1986). Indeed, the court noted that a change in meaning would be crucial: "[the addition of the letters 'UNI'] might be a significant distinction if the meaning or commercial impression conveyed by [both marks] differed ... the fact remains that both marks share the same connotation." *Id.* Similarly, the two marks at issue in *In re Phillips-Vanhusen Corp.* include identical words: 21 CLUB. The only difference is in stylization, with no difference in meaning.

The Examining Attorney asserts that the addition of a word does not obviate similarities between Applicant's mark and the registrant's mark, stating: "the addition of the word ROSE to the word HONEYSUCKLE does not obviate the similarities between the marks because its is [sic] well settled that the mere addition of a term to a registered mark does not obviate the similarity between marks." While there may be cases such as those cited by the Examining Attorney where the connotation of a mark is not changed by the addition of letters or words, this is not such a case.

The Examining Attorney erroneously asserts that the marks differ only in that the registered mark is presented with design elements and in that the Applicant has "added the wording ROSE to the registered mark." Both marks are design marks. Both marks include words. The registered mark is one word that refers to a plant. Applicant's mark is a two-word term that refers to a woman or 'feminine sweetness.' Applicant's mark is in a block-stylized font, while the registered mark is in a 3-D perspective font with intertwining floral designs that correspond to the definition of the single word 'honeysuckle'.

Applicant seeks to register a design mark including a phrase that completely differs in definition from the word HONEYSUCKLE. Thus, this case differs from those cited by the Examining Attorney, wherein marks at issue included terms whose definitions or connotations were not changed by surrounding elements of a mark or words added to the mark. In the cited cases, the court considered only a portion of the mark because the portions excised from the analysis did not change the overall commercial impression of the mark. For example, in *In re Chattam International Inc.*, the Board held that JOSE GASPAR GOLD and GASPAR'S ALE both conveyed the commercial impression that a name, GASPAR, was the source of related alcoholic beverages. 71 USPQ2d 1944 (Fed. Cir. 2004). The court "perceive[d] no error in appropriately discounting portions of JOSE GASPAR GOLD and GASPAR'S ALE that did not change the commercial impression of the marks." Similarly, in *Coca-Cola Bottling Company of Memphis, Tennessee, Inc. v. Joseph E. Seagram and Sons, Inc.*, the Court of Customs and Patent Appeals considered the marks BENGAL and BENGAL LANCER in their entirety, finding them substantially similar. 188 USPQ 105 (CCPA 1975). The court noted that both marks referred to the geographical region of India, and that the case turned on "whether the marks have a meaning

or meanings to the purchasers of the parties' goods sufficiently different to avoid a likelihood of confusion." *Id.* The Court came to a similar conclusion in *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1976), which was also cited by the Examining Attorney. In *Lilly Pulitzer*, the Court found a likelihood of confusion between opposing marks where both marks included the word Lilly, although spelled differently, and an opposing mark included an additional word "Ann." *Id.* The Court found that the addition of the word "Ann" did not change the meaning of the word Lilly -- both words refer to the name of a person. *Id.* Thus, after the marks are considered as a whole, and after determining that additional elements of the mark do not change the meaning of a particularly contested portion of the mark, it must then be determined whether the meaning of the marks is different.

Here, the Examining Attorney performed improvident dissection and piecemeal analysis of Applicant's mark, mistakenly assuming that the law requires a finding of likelihood of confusion simply because the word portion of the registered mark is a term that is subsumed in Applicant's mark:

[T]hey [sic] marks convey highly similar commercial impressions in that they share the term HONEYSUCKLE. The marks differ only in that the registered mark is presented with design elements and in that Applicant has added the word ROSE to the registered mark.

In this exercise of dissecting Applicant's mark, the Examining Attorney compares the single word HONEYSUCKLE with a mere portion of Applicant's mark in violation of the 'anti-dissection rule'; and erroneously concludes that the addition of the word "ROSE" is the only difference in the marks.

The Examining Attorney's analysis is contrary to settled trademark law: trademarks should be considered in their entirety, the way consumers encounter them in the marketplace. Their individual components or features should not be "dissected," analyzed piecemeal. *Jet, Inc. v. Sewage Aeration System. Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 49 USPQ2d 1355, 1359 (6th Circuit 1999). In *Jet Inc.*, the court noted that the "'anti-dissection rule' ... serves to remind courts not to focus only on prominent features of the mark, or only on those features that are prominent for the purposes of litigation, but on the mark in its totality." Indeed, to do so in this case would be to ignore the meaning attributed to the entire term HONEYSUCKLE ROSE.

Every point in the Examining Attorney's Answer is predicated on the evisceration of Applicant's complete mark, rather than considering the mark as a whole as required by law. For example, the Examining Attorney states "the Applicant's mark is comprised of separable elements -- the wording HONEYSUCKLE and the wording ROSE." In support of her conclusion, the Examining Attorney cites *In re Lean Line, Inc.*, 229 USPQ 781, 782 (TTAB 1986). However, the Examining Attorney's reliance on this case is misplaced. Specifically, in *Lean Line*, the court parsed the mark LEAN LINE because the court found that LEAN was merely descriptive. This case is different. Applicant's mark, when considered as a whole, has a meaning entirely different from the words HONEYSUCKLE and ROSE when parsed, and no portion of the mark is descriptive of the goods.

As noted in Applicant's Appeal Brief, HONEYSUCKLE ROSE refers to feminine sweetness. This phrase and the connotation it carries have been part of American culture for at least about 80 years. It entered the popular vernacular at least as early as the 1928 recording by Fat Waller of the song of the same name. Its common meaning was emphasized by Louis

Armstrong's recordings of ten and twenty-eight years later (in 1938 and 1955). That meaning remained evident in the popular culture twenty-five years later in the 1980 movie of the same name, starring Willie Nelson, and remains in the popular culture today as evidenced by the Willie Nelson tour bus name and Wikipedia entry. Wikipedia is a user generated encyclopedia—the essence built by the public. Thus, the definition provided is the definition provided by the public.

The Examining Attorney discounts these song recordings, movie and other uses as unrelated, isolated facts. Nothing could be farther from the reality. They are clear evidence of the continuing vitality in the public mind, over at least the last eighty years, of the connotative meaning to Americans of the term HONEYSUCKLE ROSE as something entirely different from the identify of the honeysuckle or rose plants.

The Examining Attorney appears intent on separating Applicant's words to avoid this widely known definition and maintains her assertion that the terms connote two different plants. Applicant does not deny that "HONEYSUCKLE" means "a climbing bush with twining stems," and that "ROSE" means a type of flower, among other meanings.¹ Indeed, the Examining Attorney continues in her Answer Brief to parse the mark into two words and continually restates that each word refers to plants of one form or another. The evidence is clear that the phrase "honeysuckle rose" does not refer to flowering plants, but to feminine sweetness. The definition of the phrase "honeysuckle rose" is not printed in Webster's Dictionary, but rather in the artistic

¹ Applicant does not object to the Board taking judicial notice of the definition of HONEYSUCKLE as referring to a plant, but Applicant objects to the Examining Attorney's request that the Board take judicial notice of her unwarranted conclusion that the word HONEYSUCKLE is somehow stronger than the word ROSE in Applicant's unitary mark.

record of the general American populace. In other words, feminine sweetness is the connotation of the term HONEYSUCKLE ROSE as understood in American culture.²

Because HONEYSUCKLE ROSE connotes a wholly different meaning than either of its parts separated, the mark HONEYSUCKLE ROSE must be considered in its entirety. The difference in meaning leads to the conclusion that Applicant's mark differs from registrant's mark in commercial impression.

B. Sound

Difference in meaning is not the only dissimilarity between Applicant's mark and the registered mark. The Examining Attorney completely ignores the "sound" factor of the commercial impression test. Instead, the Examining Attorney summarily dismisses Applicant's explanation that its mark is a mellifluous combination with the emphasis on ROSE by stating that "it is well settled that there is no correct pronunciation of a trademark."³ This is incorrect; the words of both marks have obviously different pronunciation and emphasis. Applicant merely points out yet another distinction between Applicant's mark and the registered mark:

HONEYSUCKLE sounds different than HONEYSUCKLE ROSE, particularly in that in

² The Examining Attorney objects to the inclusion of the lyrics of the song "Honeysuckle Rose" in Applicant's Appeal Brief. This objection is unfounded in the context of an *ex parte* appeal brief. See TBMP 1208. Applicant did not submit a new list of exhibits a "few inches thick" and "voluminous" as in *In re Psygnosis Ltd.*, 51 USPQ2d 1954, 1595 (TTAB, 1999). In any case, Applicant believes that the Board can at least take judicial notice that this song is not about flowering plants.

³ The Examining Attorney's assertion that there is no correct pronunciation of a trademark is not only not applicable to the issue at bar, but also unsupported by her citations. Specifically, in *Kabushiki Kaisha Hattori Tokeiten v. Scutotto*, the Court found the marks SEYCOS and SEIKO to be phonetic equivalents. In fact, the Court stated that "the term 'SEYCOS' is simply so close in appearance and pronunciation to 'SEIKO' as to make source confusion inevitable." 22 USPQ 461, 462 (1985).

Applicant's mark, phonetic emphasis is on the noun ROSE rather than the adjective HONEYSUCKLE. The registered mark is, of course, devoid of the term ROSE.

The Examining Attorney discounts the difference in sound based on the allegation that Applicant's mark is merely "two distinct words, each identifying a type of plant." As discussed above, this allegation flies in the face of the evidence of record showing that HONEYSUCKLE ROSE is a unitary term that does not identify any known plant.

C. Appearance

Applicant's mark differs not merely in the addition of a word. Applicant's mark differs in appearance. The registered mark is a perspective, 3-D floral design incorporating the word HONEYSUCKLE. The end of the 3-D design disappears in the distance. The floral design complements the definition of the word HONEYSUCKLE, which as the Examining Attorney noted means "a climbing bush with twining stems." Applicant's stylized mark has a block design. Thus, the two marks differ starkly in appearance.

The Examining Attorney asserts that the word portion of the mark should be accorded greater weight in determining a likelihood of confusion, but cites cases only in which single word marks with nominal differences in meaning and sound were at issue. For example, in *In re Dakin's Miniatures Inc.*, the word portion of the registered mark was given greater weight, but the protection afforded to the registrant was only for the word DAKIN. *Id.*; *see also In re Appetito Provisions Co.*, 3 USPQ.2d 1553 (TTAB 1987) (considering the single term 'appetito,' common to both marks and differing only in the addition of the letter 's'); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976) (considering the similarity in sound between the two words Amoco and Amerco; both words differing only in two letters). While TMEP

§1207.01(c)(i) notes that the greater weight may be afforded to a word or mark that comprises both a word and a design, this same section also notes that the Court of Appeals for the Federal Circuit has cautioned that "there is no general rule as to letters or designs will dominant in composite marks; nor is the dominance of letters or designs dispositive of the issue." *Citing In re Electrolite Laboratories, Inc.*, 929 F.2d 645, 647, 16 USPQ.2d 1239, 1240 (Fed. Cir. 1990).

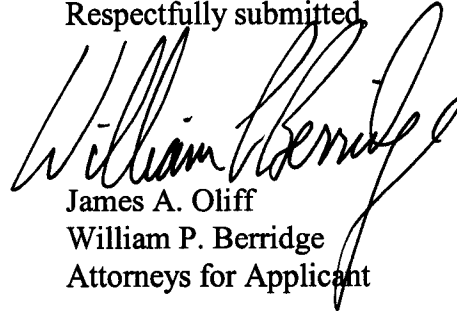
TMEP §1207.01(c)(ii) also states that comparison of composite marks must be done on a case-by-case basis without reliance on mechanical rules of construction. Indeed, more weight may be given to a dominant feature of a mark notwithstanding the anti-dissection rule if one feature of the mark is found to be more significant than another feature. As discussed above, Applicant's mark is a design mark that includes a combination of words that carries different meaning, different sound, and different appearance than either word alone, and the registrant's design focuses on the difference in meaning. Thus, this is far more than "the mere addition of a term to a registered mark."

II. CONCLUSION

When viewed in their entirety, Applicant's mark is not likely to be confused with the registered mark because they have dissimilar commercial impressions. The two marks differ in meaning. As is apparent from the Examining Attorney's study in plant taxonomy, it is clear that the registered mark differs in that it connotes plants, while Applicant's mark connotes feminine sweetness. In addition to obvious difference in appearance, the registered mark fails to contain as many syllables or words as Applicant's mark, and the emphasis lies in the added word, ROSE, which the registered mark does not include. For the foregoing reasons, it is respectfully

requested that the refusal to register Applicant's mark under §2(d) of the Trademark Act be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William P. Berridge". The signature is fluid and cursive, with a large, stylized "W" and "B".

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